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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/468,437	06/06/95	HODA	T 3408/589

NGUYEN EXAMINER

26M2/0821

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ART UNIT	PAPER NUMBER
2615	6

DATE MAILED: 08/21/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on May 20, 1996

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three months month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 20-25 and 31-42 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 20-25 and 31-42 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

– SEE OFFICE ACTION ON THE FOLLOWING PAGES –

* U.S. GPO: 1996-409-290 40029

Part III DETAILED ACTION

Specification

1. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the originally filed specification does not provide support for the invention now claimed.

The originally filed specification fails to teach a camera which comprises a first and a second semiconductor memory and a control means for changing the reproducing or recording of the first semiconductor memory (first memory) to the second semiconductor memory (second meory) as now recited in claims 20, 38, 40 and 41. It is noted that the originally filed specification and associated drawings teach a camera (1) which comprises only one semiconductor (2) (IC card) for storing images, not two semiconductors as now recited in claims 28,38,40 and 41.

Claim Rejections - 35 USC § 112

2. Claims 20-22, 33-34, 38-42 rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 23-24 and 35-36 are rejected under 35 U.S.C. § 102(e) as being anticipated by Takeuchi et al for the same reason as set forth in the previous office action, paper No 3.

Regarding new claims 35-36, Takeuchi et al further teaches a finder (9) for displaying the image taken by the apparatus and a printer (11) for printing the image by one of first memory and second memory.

5. Claims 40 and 42 are rejected under 35 U.S.C. § 102(e) as being anticipated by Orii .

Orii discloses a camera apparatus (Fig 1) comprising:

a camera body (10);

first memory (memory card 24) and second memory (26a) for storing image information;

recording means and reproducing means (50) and (25) for recording and reproducing the image information;

changing means for changing the recording from first memory to the second memory by copying the image from the first memory to the second memory and for changing the reproducing the first memory to the second memory by stopping the reproducing of the first memory and reproducing the image stored in the second memory to the monitor (27) for viewing (column 12, lines 5-68, column 15, lines 8-28); and

a finder (23) for displaying the image.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention

were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

7. Claim 25 is rejected under 35 U.S.C. § 103 as being unpatentable over Takeuchi et al in view of Watanabe et al for the same reason set forth in the previous office action, paper No 3.

8. Claims 31-32 and 37 are rejected under 35 U.S.C. § 103 as being unpatentable over Takeuchi et al in view of Watanabe et al for the same reason as set forth in the previous office action, paper No 3.

Regarding new claim 37, Takeuchi et al further teach reading means (16) for reading image from the optical disc (column 4, lines 23-53).

9. Claims 20-23 are rejected under 35 U.S.C. § 103 as being unpatentable over Takahashi in view of Lang.

See the previous office action, paper No 3, paragraph 3, for the reason which is used to rejected claims 20-23 based on Takahashi.

Takahashi fails to teach the second medium is a semiconductor memory. However, it is noted that using a semiconductor memory as an alternative storage means for storing image signal is well known in the art as taught by Lang. Lang at pages 5 and 6 teaches the use of semiconductor memory device as an alternative storage means for a video tape or an optical disc. Therefore, would have been obvious to one of ordinary skill in the art to employ a semiconductor memory as taught by Lang with the Takahashi as alternative second medium of Takeuchi for storing the image signal.

10. Claims 33 and 34 are rejected under 35 U.S.C. § 103 as being unpatentable over Takahashi in view of Lang as applied to claims 20 above, further in view of Finelli.

Takahashi fails to specifically teach a finder and a printer as recited in claims 33 and 34. However, it is noted that a camera apparatus equipped with a finder and a printer is well known in the art as taught by Finelli (See Finelli, Figs. 1 and 3). Therefore, it would obvious to one of ordinary skill in the art to employ the finder and printer as taught by Finelli into the camera apparatus of Takahashi in order to provide a copy of select image to a user.

11. Claims 38,39 and 41 are rejected under 35 U.S.C. § 103 as being unpatentable over Orii in view of Sasaki et al.

Regarding claim 41, Orii further teaches that the first memory is a semiconductor memory but fails to teach that the second memory is also a semiconductor memory as recited in claim 41. However, it is noted that employing a semiconductor memory device such as an IC card device for storing image signals and reproducing image signals is well known in the art as taught by Sasaki et al. Therefore, it is obvious to one of ordinary skill in the art to employ the semiconductor memory device as disclosed by Sasaki et al with Orii's apparatus as an alternative second memory of Orii for storing and reproducing the image signal in order to reduce the size of the overall apparatus.

Regarding claims 38 and 39, the limitations of claims are similar to claims 40-42, therefore claims 38-39 is rejected by the same reason as applied to claims 40-42.

Response to Amendment

12. Applicant's arguments filed May 20, 1996 have been fully considered but they are not deemed to be persuasive.

In Remarks, page 5, lines 13-15, aplicants argue that Takahashi fails to teach reproducing means . In response, it is submitted that inherently Takahashi apparatus includes a reproducing means mode the first and second memory means since it is required for any recording/reproducing device.

In Remarks, page 5, lines 18-23, applicants argue that "the invention of claims 23 and 24 is entirely different from Takeuchi's patent and is not anticipated " since the claims 23-24 are directed to a camera whereas Takeuchi's patent is directed to an "electronic album".

It is submitted that Takeuchi 's Patent are not only directed to an "electronic album" but also is directed to a "camera". Takeuchi reference, at column 3, lines 1-5, teach the use of image sensor for converting an objected image of a photograph into a electrical signal and then storing the electrical signal as an image signal on a recording medium. Since the apparatus of Takeuchi reference is equipped with circuits which can perform r taking an image and storing the image as this doing by a camera, the apparatus of Takeuchi et al is considered as the claimed camera apparatus as argued by the applicants.

In Remark, page 6, applicants argue that it "would not be obvious to conceive of a camera provided with reproducing means and loaddable with an IC card from Takeuchi and Watanabe et al". In response, it is submitted that it is obvious to produce the claimed invention from Takeuchi and Watanabe et al since both Takeuchi and Watanabe provide camera apparatus and loadable medium or IC card.

In Remarks, page 7, applicants argue that claims 31-32 should be patentable over the reference since they have unprecedented

technical effect. In response, it is submitted the claims 31-32 would not patentable over the references since the combination of the Takeuchi et al and Watanabe et al would produce the claims 31-32.

13. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Nguyen

whose telephone number is (703) 305-4775 and fax number is (703)308-5399.

TOMMY P. CHIN
SUPERVISORY PATENT EXAMINER
GROUP 2600

H.n
August 17, 1996